

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

NORTHROP et al.

Appln. No. 08/482,933

Group Art Unit: 1631

Filed: June 7, 1995

Examiner: A. Marschel

FOR: MICROFABRICATED REACTOR

DECLARATION OF WILLIAM J. EGAN, III

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

I, William J. Egan, III, hereby declare and state as follows:

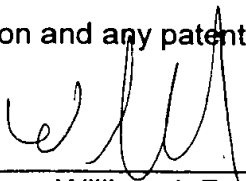
1. I am a principal with the law firm of Fish & Richardson and the attorney who filed the subject Appln. No. 08/482,933. I am a member in good standing and registered to practice before the United States Patent and Trademark Office. I have personal knowledge of the facts contained in this declaration and can competently testify to them.
2. In a time frame from before May 1, 1992 and continuing to August 31, 1992, I was a principal with the law firm of Heller, Ehrman, White & McAuliffe ("Heller"). Also during this time frame, Lawrence J. Shaw ("Mr. Shaw") was a registered patent agent who worked with me at Heller and was involved in the preparation of the parent of the subject Appln. No. 08/482,933 ("the parent application"). The parent application was filed on August 31, 1992 and issued as U.S. Patent No. 5,639,423 on June 17, 1997.

3. Mr. Shaw and I exercised due diligence in this country in preparing and filing the parent application from the period extending from before May 1, 1992 and continuing to August 31, 1992, as shown by the following:

- Prior to May 1, 1992, I was requested by Scott A. Taper, Jr. ("Mr. Taper") of the Office of Technology Licensing ("OTL") at the University of California, Berkeley to conduct prior art searches on the invention described and claimed in the subject Appln. No. 08/482,933. After the searches were completed, but still prior to May 1, 1992, I had a telephone discussion with Mr. Taper to consider how best to proceed with the filing of a patent application on the invention. Thereafter, but still prior to May 1, 1992, I spoke with Dr. M. Allen Northrup ("Dr. Northrup"), one of the two joint inventors, regarding preparation of the parent application. Specifically, we discussed the fact that we would prepare an outline of the patent application, which would be expanded later in a future meeting with Dr. Northrup. To the best of my knowledge, I was provided with one or more of Northrup Exhibits A, B and G for search purposes and for the preparation of an outline or rough draft of the patent application prior to May 1, 1992.
- On May 11, 1992, I met with Dr. Northrup and Dr. Richard M. White ("Prof. White"), the other joint inventor. During the meeting, we discussed the content of the rough draft as well as a schedule for finalizing the patent application and a date by which we hoped to file in the U.S. Patent and Trademark Office. My notes of this meeting comprise Northrup Exhibit H.

- On June 2, 1992, a rough draft of the patent application was faxed to Dr. Northrup and Dr. White. A copy of this draft was also sent to Mr. Taper (see Northrup Exhibit I).
- After receiving the inventors' comments on the draft of June 2, 1992, the patent application was revised, and the revised application was sent to Dr. Northrup and Dr. White on July 8, 1992 (Northrup Exhibit J and K).
- Thereafter, the patent application was again revised and that further revision was sent via Federal Express on August 28, 1992 to Dr. Northrup and Dr. White (Northrup Exhibit L).
- On August 31, 1992, the parent application was filed in the U.S. Patent and Trademark Office. A copy of the parent application as filed was sent to Mr. Taper, Dr. Northrup and Dr. White on the same day (Northrup Exhibit M).

4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and any patent issuing thereon.



William J. Egan, III

Date: 4/19/01